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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,074	05/01/2001	William K. Meade, II	10003986-1	6973

7590 11/30/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

OYEBISI, OJO O

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,074

Applicant(s)

MEADE, II, WILLIAM K.

Examiner

OJO O. OYEBISI

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5, and 10-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over disclosed prior art (the specification, from page 2, line 1 to page 3, line19) in view of JACKIE CHAN FAN CLUB AUSTRALIA REPORTING THE VIDEO PIRATES (CHAN hereinafter, <http://www.geocities.com/Hollywood/Set/8801/jcreport.html>, pgs 1-7).

Re claim 1. The disclosed prior art shows a method for facilitating reporting of patent infringements, the method comprising: obtaining a report of patent infringement activity from a reporter, the reporter having an identity; presenting information comprising the report to an interested party (i.e., see “only big infringements will be the ones reported in this case”, see page 2, lines 25-26, also see “of course an infringement discoverer may negotiate such a fee”, page 2, lines 19-20). The disclosed prior art does not expressly disclose the method stated supra comprising: protecting the identity of the reporter. However, CHAN discloses piracy-reporting process wherein the reporter is offered identity protection (i.e., informants can remain anonymous, see pg 2, lines 12-14, and pg 3, line 14). Further, anonymous communication is a well-known communication

process that has been successfully used for decades in equity trading whereby trading parties trade with one another anonymously over a communication network. Thus, it would have been obvious to one of ordinary skill in the art to use the conventional reporting method disclosed in the prior art in combination with CHAN or in combination with the well known anonymous communication method stated supra to protect reporter's identity, leading to frequent infringement reporting.

Re claim 2. The disclosed prior art discloses a method wherein the interested party is a patent owner (i.e., companies with strong licensing programs typically have 4-30 people dedicated to the task of policing their portfolio, see pg 2, lines 7-8).

Re claim 3. The disclosed prior art does not explicitly disclose a method further comprising receiving compensation for the presenting. CHAN makes this disclosure (i.e., there is a reward of up to HK\$100,000 for information that leads to an arrest and/or to seizure of pirated goods, see CHAN pg 2, last 2 lines). Thus, it would have been obvious to one of ordinary skill in the art to implement the reward process of CHAN in the conventional reporting method disclosed in the prior art to motivate infringement reporters to report more cases of patent infringement.

Re claim 4. The disclosed prior art does not explicitly disclose a method comprising providing compensation to the reporter for the report. CHAN makes this disclosure (i.e., there is a reward of up to HK\$100,000 for information that

leads to an arrest and/or to seizure of pirated goods, see CHAN pg 2, last 2 lines). Thus, it would have been obvious to one of ordinary skill in the art to implement the reward process of CHAN in the conventional reporting method disclosed in the prior art to motivate infringement reporters to report more cases of patent infringement.

Re claim 5. Neither the disclosed prior art nor CHAN expressly discloses a method further comprising persisting and organizing the report in a database containing similar reports. However, it is well-known that businesses always keep and organize important information in a database for easy access. Thus, it would have been obvious to one of ordinary skill in the art to organize the report in a database containing similar reports for easy access and retrieval of the said reports.

Re claims 10-11. Claims 10 and 11 recite similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

Re claim 12. The limitation “wherein the identity of the reporter is protected during the presenting” is part of the limitations recited in claim 1, and thus rejected using the same rationale in claim 1.

Re claim 13. The disclosed prior art discloses a method wherein multiple reports are obtained by the obtaining and multiple reports are presented by the presenting (i.e., only big infringements will be the ones reported, see pg 2, lines 25-27).

Re claim 14. The disclosed prior art does not expressly disclose a method further comprising classifying the multiple reports. However, CHAN makes this disclosure (i.e., all such information will be treated in strict confidence, see page 3, the last line under Customs and Excise Department). Thus, it would have been obvious to one of ordinary skill in the art to implement CHAN's method in the disclosed prior art to protect reporter's identity, leading to frequent infringement reporting.

Re claim 15. The disclosed prior art further discloses a method wherein the violation is an infringement of an intellectual property right (i.e., patent infringement, page 1, lines 10-12).

Re claim 16. The disclosed prior art further discloses a method as stated supra wherein the intellectual property right is related to a one or more rights selected from a group consisting patents, copyrights, trademarks, trade dress, trade dilution, trade secrets, and unfair competition (see pg 1, lines 10-12).

Re claim 17. The disclosed prior art discloses a method wherein the violation is a violation of one or more laws selected from a group consisting of environmental laws and customs laws (i.e., Patent/Trademark infringement, which is nothing but a violation of custom laws).

Re claim 18. Claim 18 recites similar limitations to claim 2, and thus rejected using the same art and rationale in the rejection of claim 2.

Re claim 19. Claim 19 recites similar limitations to claim 3 above, and thus rejected using the same art and rationale in the rejection of claim 3.

Re claim 20. Claim 20 recites similar limitations to claim 4 above, and thus rejected using the same art and rationale in the rejection of claim 4.

Re claim 21. Claim 21 recites similar limitations to claim 5 above, and thus rejected using the same art and rationale in the rejection of claim 5.

Re claim 22. Claim 22 recites similar limitations to claim 6y above, and thus rejected using the same art and rationale in the rejection of claim 6.

Re claim 23. Claim 23 recites similar limitations to claim 7 above, and thus rejected using the same art and rationale in the rejection of claim 7.

Re claim 24. Claim 24 recites similar limitations to claim 8 above, and thus rejected using the same art and rationale in the rejection of claim 8.

Re claim 25. Claim 25 recites similar limitations to claim 9 above, and thus rejected using the same art and rationale in the rejection of claim 9.

Re claim 26. The disclosed prior art does not disclose a method wherein the obtaining comprises receiving report via the Internet. CHAN makes this disclosure (i.e., information may also be furnished via E-MAIL if directed to the email hotline, hotline@mpaa.org, see page 3, The Motion Picture Association of America). Thus, it would be obvious to one of ordinary skill in the art to implement CHAN's in the disclosed prior art to provide nomadic access to reporters, leading to increase in patent infringement reporting.

Re claim 27. The disclosed prior art does not disclose a method wherein the obtaining comprises generating Web pages for delivery over the Internet.

However, CHAN makes this disclosure (i.e., hotline@mpaa.org). Thus, it would

been obvious to one of ordinary skill in the art to implement CHAN's in the disclosed prior art to provide nomadic access to reporters, leading to increase in patent infringement reporting.

Re claims 28-31, and 33. Claims 28, 29, 30, 31 and 33 recite similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

Re claim 32. Claim 32 recites similar limitations to claim 15 above, and thus rejected using the same art and rationale in the rejection of claim 15.

Re claim 34. Claim 34 recites similar limitations to claim 21 above, and thus rejected using the same art and rationale in the rejection of claim 21.

Re claim 35. Claim 35 recites similar limitations to claim 15 above, and thus rejected using the same art and rationale in the rejection of claim 15.

3. **Claims 6-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over The disclosed prior art in view of CHAN and further in view of **subpart 227.70--infringement claims, licenses, and assignments** (SUB hereinafter, http://www.acq.osd.mil/dpap/dars/dfars/html/current/227_70.htm, pgs 1-6).

Re claim 6. The disclosed prior art further discloses a method wherein the reporter is an infringer (i.e., only big infringements will be the ones reported in this fashion, see pg 2, lines 25-27). Neither The disclosed prior art nor CHAN discloses the method further comprising facilitating a resolution of an infringement conflict between the interested party and the infringer. However, SUB makes this disclosure (see **Requirements for filing an administrative**

claim for patent infringement, pgs 1-3). Thus, it would have obvious to one of ordinary skill in the art to combine the conventional method disclosed in the prior art and CHAN with SUB to make sure that all necessary steps are taken to settle administratively the infringement claims prior to suit against the infringer.

Re claim 7. Neither the disclosed prior art nor SUB discloses a method wherein, during the facilitating, the identity of the infringer is protected. However, CHAN discloses piracy-reporting process wherein the reporter is offered identity protection (i.e., informants can remain anonymous, see pg 2, lines 12-14, and pg 3, line 14). Further, anonymous communication is a well-known communication process that has been successfully used for decades in equity trading whereby trading parties trade with one another anonymously over a communication network. Thus, it would have been obvious to one of ordinary skill in the art to use the disclosed prior art reporting method in combination with CHAN and SUB or the well known anonymous communication method stated supra to protect reporter's identity, leading to frequent infringement reporting.

Re claim 8. Neither the disclosed prior art nor CHAN discloses a method further comprising facilitating transfer of fee resulting from the resolution from the infringer to the interested party. SUB makes this disclosure (see **Investigation and administrative disposition of claims**, 227.7006, pg 3 (i.e., the funds of that Department only are to be charged in the settlement of the claim), also see **settlement of indemnified claims**, 227.7008, pg 4). Thus, it would have been obvious to one of ordinary skill in the art to combine the disclosed prior art with

CHAN and SUB to compensate patent owners for their disclosures.

Re claim 9. Claim 9 recites similar limitations to claim 8, and thus rejected using the same rationale in the rejection of claim 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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